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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,781	11/20/2003	Christopher J. Burt	203995-1 (5024-00289)	1536
26753 7590 12/23/2008 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
EXAMINER LUBIN, VALERIE				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,781

Applicant(s)

BURT ET AL.

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 1-39 are pending

For reference purposes, the document paper number is 20081210

Response to Arguments

2. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.
3. The rejection of claims 15 and 34 under 35 USC § 112, 2nd paragraph is withdrawn in light of Applicant's amendments.

4. A new rejection under 35 USC § 101 has been asserted below, as necessitated by amendment for claims 1-39. Examiner notes that the amended claims 1 and 18 describe "counters" as data, where as in the previous claims 1 and 18, the term "counter" was given the broadest reasonable interpretation of a device for counting.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 1-17 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876), *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

8. Claims 18-39 are rejected because they are directed a system which merely comprises data and software, which do not constitute patent eligible classes.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boukobza et al., U.S. Patent No. 6,122,664 in view of Shipon, U.S. Pre-Grant Pub No. 2003/0023459.

11. With respect to claim 1, Boukobza recites a method comprising the steps of polling a set of data (Abstract); transforming the set of data into a plurality of counters (Col. 9 lines 33-35); monitoring one or more performance parameters of a system by recording the values of

the parameters by one of a plurality of counters; comparing the value of the counters to thresholds (Abstract, column 2, lines 50-52; column 32, lines 10-11).

Boukobza recites measuring health indicators (Column 9, lines 23-26), but he does not specifically disclose a healthcare information system. However, Shipon discloses a healthcare information system (§ 52). It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Boukobza and Shipon to measure performance parameters of a healthcare system in order to ensure that the system is operating properly.

Boukobza recites notifying a user of a problem (Column 17, 58-67; column 32, lines 17-20). A predictable result of Boukobza would therefore be to notify a representative for any abnormal observation of parameters (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)). Furthermore, the limitation of "notifying a designated representative if..." is optional language, and according to the MPEP, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (2106.II.C).

Claim 15 is rejected under the analysis of claim 1.

12. Concerning claim 2, Boukobza discloses taking measurements at predetermined intervals (Column 6, lines 64-66).

13. For claims 3-5, the type of parameters being measured is non-functional descriptive material that does not further limit the process steps found in claim 1, i.e. monitoring, comparing and notifying (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70

USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Therefore, claims 3-5 are rejected under the analysis of claim 1.

14. Claims 6-10 are rendered obvious, as Boukobza recites notifying a management system (Column 18, lines 58-67) and notifying an administrator of the monitored application (Column 32, lines 17-20). A predictable result of Boukobza would therefore be to notify any necessary device, system or person in order to have the application or system repaired (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

Claims 26-30 are rejected under the analysis of claims 6-10.

15. Claims 11 and 12 are also rejected, as Boukobza recites a user defining thresholds (Column 9, line 67; column 10, lines 1-4, 23-26).

Claims 31 and 32 are rejected under the analysis of claims 11 and 12.

16. With respect to claim 13, Boukobza discloses receiving an acknowledgement of receipt of the notification, an instruction of an action to be performed, and performing the action (Column 17, lines 62-67; column 18, lines 4-7).

17. Claim 14 is an optional limitation which is not required to be performed, and therefore does not further limit the process of claim 13. Claim 14 is therefore rejected under the analysis of claim 13.

18. Claim 16 is rendered obvious over Boukobza who recites determining a numerical value for performance parameters (Column 15, lines 10-12; column 27, lines 64-65).

Claim 35 is rejected under the analysis of claim 16.

19. Regarding claim 17, Boukobza discloses displaying a user interface to show parameter curves, conditions, actions and later analysis (Column 3, lines 60-67; column 4, lines 1-4). Therefore, claim 17 is rendered obvious over the prior art.

Claim 36 is rejected under the analysis of claim 17.

Claim 37 is also rejected under the analysis of claim 17, as it recites a duplicated component and it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

20. Claim 18 is rejected, as Boukobza recites a system comprising a notification agent (Col. 6 lines 22-26) and a plurality of modules to measure performance parameters and one or more autonomous agents (Abstract).

Claim 34 is rejected under the analysis of claim 18.

Claims 38 and 39 are also rejected under the analysis of claim 18.

21. With regards to claim 19, Boukobza discloses an operator capable of taking action (Abstract; column 2, lines 46-52).

Claims 20 and 21 are rejected under the analysis of claim 19.

22. For claim 22, Boukobza discloses taking measurements at predetermined intervals (Column 6, lines 64-66).

23. For claims 23-25, the type of parameters being measured is non-functional descriptive material that does not further limit the system found in claim 18 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Therefore, claims 23-25 are rejected under the analysis of claim 18.

24. Claim 33 is an optional limitation which is not required to be performed, and therefore does not further limit claim 18. Claim 33 is therefore rejected under the analysis of claim 18.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626